REMARKS

Claim 1 has been amended to require the presence of adenosine (so it corresponds to previous claim 23).

Claims 2, 3, 5, 6, 8, 9, 11, 12, 14, 15, 17, 18, 22 and 23 have been canceled.

Claims 1, 4, 10, 13 and 19-21 are currently pending.

The Office Action rejected claims 1, 2, 4 and 5 under 35 U.S.C. § 102 as anticipated by U.S. patent 3,978,213 ("Lapinet"), and claims 1-6, 8-15 and 17-23 under 35 U.S.C. § 103 as obvious over U.S. patent 6,423,327 ("Dobson"). In view of the following comments, Applicant respectfully requests reconsideration and withdrawal of these rejections.

The pending claims relate to methods of softening expression lines using specified amounts (0.1-10%, more specifically 0.1-1.0%) of adenosine. Of particular note, the invention methods require direct application of the specified amount of adenosine to the expression lines with the intent and effect of softening the expression lines. None of the applied art teaches or suggests these unique treatment methods.

Initially, Applicant notes that Lapinet does not relate to adenosine. The Office Action recognized this fact – previous claim 23 was not rejected over Lapinet. Given that the claims have been amended to require the presence of adenosine, Applicant respectfully submits that the rejection based upon Lapinet has been rendered moot, and that this rejection should be withdrawn.

Regarding Dobson, this reference teaches applying minimal, millimolar amounts of adenosine such that dermal cell proliferation is avoided. Thus, the express teaching of Dobson is to strictly limit the amount of adenosine used to achieve a desired effect while,

importantly, avoiding an undesired effect resulting from the use of too much adenosine. In other words, Dobson expressly teaches away from using "significant" (that is, greater than 10^{-3} M) amounts of adenosine. This is in sharp contrast to the claimed invention which requires the presence of a significant amount of adenosine compound to achieve the required dermo-relaxation effect. One skilled in the art, following Dobson, would be led to use extremely minimal amounts of adenosine and, thus, would be led away from the presently claimed invention which requires application of significant amounts of adenosine compound to effect dermo-relaxation. Given this fundamental teaching away by Dobson, Dobson cannot teach or suggest the claimed invention.

In this regard, Applicant notes the attached precedential opinion from the Board of Patent Appeals and Interferences in *Ex parte Whalen* (Tab A). In *Whalen*, the Examiner's obviousness rejection was based on the reasoning that a person of ordinary skill in the art would have been motivated to optimize a specific property of prior art embolizing compositions (viscosity) because he would have had a reasonable expectation of success in achieving the safest clinical outcome and avoiding transvenous passage of the embolizing composition. (Pages 13-14). The Board rejected this reasoning, and concluded that the Examiner had not made out a *prima facie* case of obviousness.

Initially, the Board noted that "while discovery of an optimum value of a variable in a normal process is normally obvious, this is not always the case. One exception to the rule is where the parameter optimized was not recognized in the prior art as one that would affect the results." (Page 14).

The Board explained that the Examiner had not pointed to any teaching in the cited references, or had not provided any reasoning based on scientific reasoning, that would support the conclusion that it would have been obvious to optimize the prior art embolizing compositions by increasing viscosity to the levels required by the claims. In fact, the Board stated, the prior art suggested a low viscosity was desired (pages 14-15), leading the Board to conclude that "in our view, none of the cited references would have led a person of ordinary skill in the art to modify the known embolic compositions by increasing their viscosity..." (Page 15).

The Board then reasoned that *KSR* stands for the proposition that when prior art teaches away from the claimed solution, obviousness cannot be proven merely by showing that a known composition cold have been modified by routine experimentation or solely on the expectation of success – it must be shown that some apparent reason to modify the known composition in the required manner existed. (Page 16).

Following *Whalen*, it is clear that Dobson does not render the claimed methods obvious. As noted above, Dobson teaches using minimal amounts of adenosine (just as the prior art in *Whalen* taught that low viscosity compositions were desirable). Also, no apparent reason to ignore Dobson's teachings and to increase adenosine concentration exists (just as no apparent reason to increase viscosity existed in Whalen). Accordingly, no *prima facie* case of obviousness exists.

Furthermore, the pending rejection over Dobson is improper because in making the pending rejection, the Office Action asserted that because expression lines are a type of wrinkle and because Dobson relates to treating wrinkles, Dobson therefore relates to treating

expression lines. However, the logic upon which this assertion is based is flawed, meaning that the rejections themselves are flawed.

As demonstrated by Exhibits A-C relied upon by the Office Action, expression lines differ from other wrinkles such as those caused by sun damage, and expression lines are "difficult to treat." Thus, merely because a reference might disclose methods of treating other types of less difficult-to-treat wrinkles, it does not mean that such a reference (directed to a different type of wrinkle) teaches or suggests anything about how to treat expression lines. In other words, for example, a disclosure related to treating wrinkles caused by sun damage cannot teach or suggest how to treat expression lines, which are recognized as being different, more difficult-to-treat types of wrinkles.

By way of analogy, baldness can be caused by different mechanisms such as, for example, alopecia or testosterone-related baldness. However, whereas testosterone-related baldness might be treatable using compounds which inhibit testosterone production or inhibit conversion of testosterone to active forms, alopecia cannot be treated using such compounds. Thus, although the effect (baldness) is the same, treatment methods are not interchangeable for the different types of baldness.

Similarly, in this case, treatment methods for treating one type of wrinkle are not interchangeable with methods for treating expression lines. Accordingly, references directed to treating wrinkles other than expression lines cannot teach or suggest methods of how to treat expression lines.

Dobson does not teach or suggest softening expression lines by applying adenosine thereto. Rather, Dobson teaches treating wrinkles or damaged skin caused by sun, age and/or

environmental factors such as wind. (See, Dobson at col. 1, lines 28-34). As explained in the present specification (pages 2-4), the conditions treated by Dobson are different from expression lines: their causes are different and their treatments are different. For example, whereas wrinkles are caused by lack of collagen and can be addressed through collagen protection and/or synthesis, expression lines are caused by different mechanisms and cannot be addressed by increasing or protecting collagen. Thus, although Dobson teaches addressing collagen-related conditions such as wrinkles or moisture-related conditions such as dry skin, these references neither teach nor suggest reducing or softening conditions unrelated to collagen or moisturization levels. Because expression lines are not collagen- or moisturization-related, Dobson could not possibly teach or suggest anything concerning treatment of this condition.

In view of the above, Applicant respectfully requests reconsideration and withdrawal of the rejections under 35 U.S.C. §§ 102 and 103.

Applicant believes that the present application is in condition for allowance. Prompt and favorable consideration is earnestly solicited.

Respectfully submitted,

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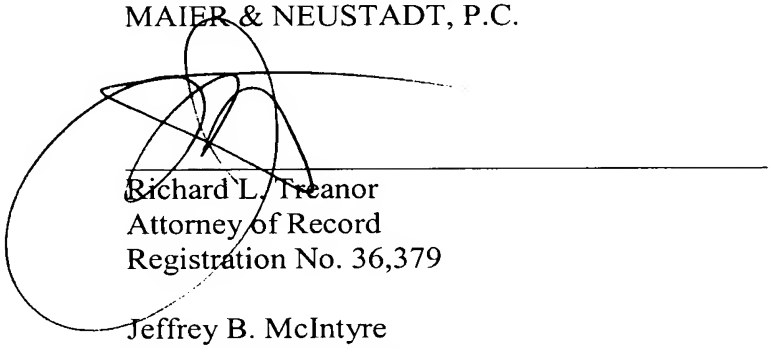

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